

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

Michael Smith

Serial No.: 09/883,014

Filed: June 15, 2001

Atty. File No.: 42059-01360

Confirmation No.: 9634

For: "System and Method for Address Book
Customization for Shared EMessaging"

) Group Art Unit: 2171

) Examiner: Leroux, Etienne Pierre

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<p style="text-align: center;">CERTIFICATE OF MAILING</p> <p>I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450 ON AUGUST 8, 2005.</p> <p style="text-align: center;">MARSH FISCHMANN & BREYFOGLE, LLP</p> <p>BY:  MAUREEN SILEO</p>

STATEMENT OF REASONS FOR REQUESTING REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant submits this Statement of Reasons for Requesting Review as an attachment to form PTO/SB/33 (07/05) and pursuant to Official Gazette Notices, July 12, 2005, Notice 12 ("New Pre-Appeal Brief Conference Pilot Program").

Review is respectfully requested for the above Patent Application. Applicant respectfully submits that the examiner has omitted an essential element required in a *prima facie* rejection of independent claims 8 and 15 and dependent claims 9-11, 14, 16, 18-20. Specifically, Applicant notes that claim 8 recites the elements of "wherein the identification information includes

hierarchal information” and “based on the hierarchal information, searching the shared directory to identify all of the at least one address entries in the directory which include the hierarchal information.” Claim 15 recites the elements of “a plurality of address entries, each of the address entries including hierarchal information in an additional field, the hierarchal information being associated with at least one entity of the entities having access to the shared directory.”

Applicant submits that none of these elements in either claim are taught by the prior art as cited by the Examiner and as such the Examiner has omitted an essential element required in a *prima facie* rejection of independent claims 8 and 15, and claims 9-11, 14, 16 and 18-20 through their dependency on claim 8 and 15, respectively.

Applicant references the arguments made of record in this regard. Specifically, Applicant references Applicant’s Amendment and Response of June 6, 2005, page 4-5 (page 4, fourth paragraph, as continued on page 5). Applicant notes that in the following Advisory Action, the Examiner stated that these arguments were merely arguing the semantics of “hierarchical database.”

Applicant submits that there is, in fact, a material difference between a hierarchical database as disclosed by the prior art and the database of the present invention that uses hierarchal information. Importantly, this distinction does not depend on semantics or the alternate spelling of hierarchical as hierarchal. Applicant notes that the prior art of record, and specifically Olds (USPN 5,878,415), does not reference that the identification information of a querying entity includes hierarchal information, much less that such hierarchal information is also included in the at least one address entries. Rather, Olds teaches a hierarchical database with administered objects that contain, because of its nature and operation as a hierarchical database, access control properties – inherited or otherwise (Figure 5 and Column 8, Lines 35-

46). Therein, Olds does not teach address entries including identification information of a querying entity, much less that hierarchal information is included as a subset of the querying entity's identification information. Particularly, Olds teaches properties of the access control and their function (Figure 5 and Column 8, Line 61 to Column 9, Line 34) without referencing hierarchal information that is included both in identifying information of a querying entity and in the at least on address entries.

Applicant further submits that the other prior art of record fails to teach the above elements. Applicant refers to Applicant's Amendment and Response of December 15, 2004, page 5-6 (page 5, fourth paragraph, through page 6, first full paragraph), for further argument on record in this regard.

Based upon the foregoing, Applicant believes that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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